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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,048	10/02/2003	John D. Inelli	ROYAL-4	7770
23599	7590	03/10/2006		
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			EXAMINER SLACK, NAKON N	
			ART UNIT 3635	PAPER NUMBER

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/676,048	Applicant(s) INELLI, JOHN D.	
	Examiner Naoko Slack	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) 2, 5, 6, 17-19, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 7, 8, 10-16 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/20/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to the Election of Species requirement, applicant has elected Figures 1 and 2, claims 1, 3, 4, 6, 7, 8, 10-16, 21, 22, and 23. Claims 2, 5, 17-19, 24, and 25 are withdrawn from consideration. Claim 6 has also been withdrawn from consideration as depending from non-elected claim 5. As requested by applicant, claims 9 and 20 have been canceled. Applicant's arguments are moot in view of newly cited prior art. An examination of pending claims 1, 3, 4, 7, 8, 10-16, 21, 22, and 23 is herein presented.

Information Disclosure Statement

Applicant's information disclosure statement received June 20, 2005 has been entered and considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 7, 8, 10-16, 21-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US Patent 6,055,782 to Morton et al.

Claim 1:

Morton et al. discloses a window sleeve arrangement comprising upper and lower walls joined by side walls, the upper, lower, and side walls (column 4, lines 22-34), each having an inner surface and an outer surface, an inner edge configured for positioning adjacent to the interior surface of a building wall, and an outer edge for positioning adjacent to an exterior surface of a building wall; the upper, lower, and side walls are an extrusion of plastic material (column 2, lines 56-59); a first flange (nailing fin 38, Figures 3 and 4) disposed around the upper, lower, and side walls of the window sleeve and extending laterally outward from the outer surfaces of the walls at a location intermediate the inner and outer edges of the walls, the first outer flange configured for engaging and being secured to the exterior surface of a building wall to retain the window sleeve within the opening; a second outer flange (50, Figures 3 and 4) located substantially at the outer edges of the walls and spaced from the first outer flange defining a gap there between for receiving sheathing (100, Figures 3 and 4) or an outer covering of the building; an inner flange (158, Figure 3 and same location in Figure 4) disposed adjacent to the outer edges of the walls and extending inwardly from the inner surface of the walls, the inner flange forming a stop configured for engaging an independent window unit (63, Figures 3 and 4) to position a window unit within the sleeve in proximity with the exterior surface of an independent building wall; and an inside stop arrangement (removable stop 74, Figures 3 and 4) positioned in spaced relation to the inner flange to define a space there between configured for locating an independent window unit and for engaging an independent window unit to hold an independent window unit against the inner flange.

The phrase "walls are a continuous extrusion of plastic material having abutting edges positioned at cuts through the continuous extrusion" (lines 9-10) implies a method of manufacture which is not limiting in article claims. Determination of patentability is based on the product itself. See MPEP 2113. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

Claim 3:

The inside stop arrangement (74) includes a molding strip for engaging an independent window unit (63), the molding strip having a connection for fastening the molding strip to the inner edges of the walls (lower end of strip 74 engages frame groove at upper end of 156, Figure 3 and 164, Figure 4).

Claims 7 and 12:

The inner surfaces of the walls extending from the inner edge to the inner flange are planar (window unit rests on planar portions, Figure 3) and unobstructed and wherein the shape and size of the space defined by the inner surfaces of the walls complements the shape and size of the independent window unit.

Claims 8 and 11:

The outer surfaces of the walls extending from the inner edge to the first outer flange are unobstructed (29, Figures 3 and 4) complementing the opening through the enclosure wall.

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Claims 10, 15, and 16:

The plastic material is polyvinyl chloride (column 2, lines 56-59).

Claims 13 and 14:

The first outer flange (38, Figure 3 and 4) receives a nail (41, Figures 3 and 4).

Claims 21-23:

As stated above, steps in the method of manufacture are not limiting in article claims. Therefore, the forming of the window sleeve by extruding, cutting, folding, and joining of edges with adhesives or fasteners all comprise method steps.

Claims 1, 3, 7, 8, 11-15, 21-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US Patent 6,334,283 to Edger.

Claims 1 and 15:

Edger discloses a window sleeve arrangement comprising upper and lower walls joined by side walls, the upper, lower, and side walls (column 3, lines 60-65), each having an inner surface and an outer surface, an inner edge configured for positioning adjacent to the interior surface of a building wall, and an outer edge for positioning adjacent to an exterior surface of a building wall; the upper, lower, and side walls are a plastic material (as illustrated by alternating dark and light cross-hatching in Figure 2); a first flange (nailing fin 29, Figure 2) disposed around the upper, lower, and side walls of the window sleeve and extending laterally outward from the outer surfaces of the walls at a location intermediate the inner and outer edges of the walls, the first outer flange configured for engaging and being secured to the exterior surface of a building wall to

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retain the window sleeve within the opening (column 3, lines 60-65); a second outer flange (26, Figure 2) located substantially at the outer edges of the walls and spaced from the first outer flange defining a gap there between for receiving sheathing (28, Figure 2) or an outer covering of the building; an inner flange (outer stop formation 36, Figure 2) disposed adjacent to the outer edges of the walls and extending inwardly from the inner surface of the walls, the inner flange forming a stop configured for engaging an independent window unit to position a window unit within the sleeve in proximity with the exterior surface of an independent building wall (column 3, lines 66-67); and an inside stop arrangement (snap-in stop 44, Figure 2) positioned in spaced relation to the inner flange to define a space there between configured for locating an independent window unit and for engaging an independent window unit to hold an independent window unit against the inner flange (column 4, lines 5-9).

The phrase "walls are a continuous extrusion of plastic material having abutting edges positioned at cuts through the continuous extrusion" (lines 9-10) implies a method of manufacture which is not limiting in article claims. Determination of patentability is based on the product itself. See MPEP 2113. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

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Claim 3:

The inside stop arrangement (44) includes a molding strip for engaging an independent window unit (45), the molding strip having a connection for fastening the molding strip to the inner edges of the walls.

Claims 7 and 12:

The inner surfaces of the walls extending from the inner edge to the inner flange are planar (ledges 41 and 42, Figure 2) and unobstructed and wherein the shape and size of the space defined by the inner surfaces of the walls complements the shape and size of the independent window unit.

Claims 8 and 11:

The outer surfaces of the walls extending from the inner edge to the first outer flange are unobstructed (lower surface of 25, Figure 2) complementing the opening through the enclosure wall.

Claims 13 and 14:

The first outer flange is a nailing fin (29, Figure 2) which receives nails for attachment to the underlying building structure.

Claims 21-23:

As stated above, steps in the method of manufacture are not limiting in article claims. Therefore, the forming of the window sleeve by extruding, cutting, folding, and joining of edges with adhesives or fasteners all comprise method steps.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,334,283 to Edger in view of US Patent 6,055,782 to Morton et al.

Claims 10 and 16:

While Edger illustrates that the window sleeve arrangement comprises plastic (cross-hatch for plastic member F2, Figure 2), Edger does not specify that the plastic comprises polyvinylchloride (PVC). However, it is very common to form window sleeves of PVC, as taught by Morton et al. Like Edger, Morton et al. discloses a window sleeve arrangement of extruded polyvinyl chloride (PVC). In view of Morton et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to form Edger's window sleeve of PVC, as Edger is concerned with improving water resistance.

Allowable Subject Matter

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose current telephone number is 571-272-6848. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naoko Slack
Primary Examiner
Art Unit 3635

NS
March 6, 2006